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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.    | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------|------------------|
| 10/065,805   | 11/21/2002  | John E. Boisseau     | IN-5591                | 7976             |
| 26922  | 7590        | 06/23/2004           | EXAMINER               |                  |
| BASF CORPORATION<br>ANNE GERRY SABOURIN<br>26701 TELEGRAPH ROAD<br>SOUTHFIELD, MI 48034-2442 |             |                      | NILAND, PATRICK DENNIS |                  |
|  |             |                      | ART UNIT               | PAPER NUMBER     |
|  |             |                      | 1714                   |                  |

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/065,805

**Applicant(s)**

BOISSEAU ET AL.

**Examiner**

Patrick D. Niland

**Art Unit**

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/15/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/4/04 has been entered.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4139514 Bassett in view of WO 99/09104 Collins et al..

Bassett discloses a clear coat containing dioctyl sodium sulfosuccinate as an emulsifier and the other ingredients of the instant claims. See column 6, lines 23-24; column 7, lines 1-54; and column 10, lines 18-44. Such a compound will necessarily reduce the ability of rain to bead on a surface, i.e. increase the ability of water to wet the surface, just as it increases the ability of water to wet the particles of the dispersion. The applicant has not considered all the other parts of the reference cited by the examiner and has not shown that they do not contain the instantly claimed amounts of dioctyl sodium sulfosuccinate. By definition, a surfactant reduces the surface tension between one medium and another. In these cases the binder and the water of the

emulsion. Rain, being water, will therefore have its surface tension reduced likewise by the dioctyl sodium sulfosuccinate remaining in the film and it will thereby be wetted with water just as the emulsified particles of the polymer are wetted with water. The applicant's contention regarding the claimed requirement of reducing the ability of rain to bead on a film of clearcoat is therefore expected in the patentee's film since the ability to wet the film is the same as the claimed requirement of reducing the ability of rain to bead on a film. Thus, the applicant's method claims are obvious in view of the patentee's coating method. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed amount of the instantly claimed surfactant because the patentee is silent as to the amount of surfactant used, it is therefore taken as being within the ability of the ordinary skilled artisan to choose the amount of surfactant desired, and Collins et al., page 6, lines 12-25 shows the instantly claimed amount of surfactants, based on the resin, crosslinker, and surfactant, to be commonly used surfactant amounts which are expected to impart the desired function of the "surfactant" of the patentee. No unexpected results stemming from the difference between the cited prior art and the instantly claimed invention, in a manner which is commensurate in scope with the instant claims and the cited prior art, are seen. For the above reasons, this rejection is maintained.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Niland whose telephone number is (571) 272-1121. The examiner can normally be reached on Monday through Thursday from 10 a.m. to 5 p.m.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

pn

June 21, 2004



Patrick Niland  
Primary Examiner  
Art Unit 1714